



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,670	12/16/2003	Gakushi Aota	8071-1001	2825
466	7590	07/26/2006	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			ISSAC, ROY P	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,670

Applicant(s)

AOTA, GAKUSHI

Examiner

Roy P. Issac

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Status of the Application

This application, filed 16 December 2003, does not claim priority to any foreign or domestic applications. Claims 1-15 are currently pending and are examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 13, the only independent claims in the application refers to "at most 0.7 μm " as the dispersed particle size. The lack of a lower limit renders the claim indefinite.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 13, the only independent claims in the application, refers to "at least 90vol%" as portion of the pigment that has dispersed particles of specified diameter. The lack of an upper limit renders the claim indefinite.

Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "thickener" is not

Art Unit: 1623

clearly defined in the specification. There can be very many additives that can increase the density of a solution containing a pigment. There are a multitude of thickeners known in the prior art and the specification provides no guidelines as to which thickeners are excluded. Hence, one of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as to the claimed process encompassed by the recited term herein.

Claims 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "cosmetic ingredient" is not clearly defined in the specification. There are a multitude of additives that can be considered as a "cosmetic ingredient." The specification provides no guidelines as to which of these additives are excluded. Hence, one of ordinary skill in the art could not ascertain and interpret the metes and bounds of the patent protection desired as to the claimed process encompassed by the recited phrase herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1623

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-6, 9-10, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ser et. al. (U.S. Patent No. 5,580,546; PTO-Form 892; Cited by the examiner).

Ser et. al. discloses a cosmetic composition containing a pigment as a solid dispersion of polyhydric alcohol for cosmetic use. (Abstract). The dispersion has an average particle size between 0.03 μm and 0.5 μm . (Column 6, lines 1-17, Example 3). This reported particle size is within the range specified in claim. Even though the '546 patent does not specify that at least 90% of the pigment dispersion has a dispersion diameter of less than 0.7 μm , the reported average particle diameter of 0.03-0.5 μm is well below 0.7 μm of the instant application. As such, one of ordinary skill in the art will expect that the dispersion disclosed in Ser et. al. has at least 90% of the pigment has a dispersion diameter less than 0.7 μm . Ser et. al. further discloses the use of a polymer (polyethylene) and other ingredients that can be considered as thickeners, for example, Carnauba wax. (Column 6, lines 1-17, Example 3). Various types of surfactants can be used as dispersants. (Specification, Page 6, lines 5-10). Ser et. al. discloses the use of hydrocarbon surfactants to achieve finer dispersion. (Column 2, lines 25-32). Ser et. al. further discloses the use of polyethylenes as surfactants for dispersion. (Column 2, lines 38-42). Ser et. al. further discloses the use of dispersion pigments. (Column 5, lines 50-55). Ser et. al. further

Art Unit: 1623

discloses the use of polymer, in particular, polyethoxylated compounds, for the formation of emulsion. (Column 1, lines 25-29).

Claims 1-15 are further rejected under 35 U.S.C. 102(b) as being anticipated by Hall-Goulle et. al. U.S. Patent No. 6,001,168; PTO-Form 892; Cited by the examiner).

Hall-Goulle et. al. claims a pigment dispersion comprising a polymer and a pigment compound in a water free or water-containing solvent with an average particle size of less than 0.5 μm . (Column 12-13, Claim 1; Column 3, lines 32-45). The pigment is disclosed as useful in cosmetic compositions. (Column 1, lines 25-30). Water is considered a cosmetic ingredient. The reported particle size of 0.5 μm is well below the 0.7 μm recited in claims 1 and 13. Various types of surfactants can be used as dispersants, including water-soluble polymers. (Specification, Page 6, lines 5-10). Hall-Goulle describes the use of polymers in water-containing pigment dispersions that has hydrophilic regions. Hall-Goulle further discloses the use of surfactants in the pigment dispersion. (Column 5, lines 10-27). Hall-Goulle further discloses the use of the pigment dispersion as a coloring agent. (Column 7, lines 27-33). Hall-Goulle further discloses the use of mixtures of water and water-free organic solvents. Emulsions are mixtures of solvents that do not dissolve in each other. One of ordinary skill in the art will know that mixtures of organic solvents and water will form emulsions.

Thus, claims 1-15 are anticipated by Hall-Goulle et. al.

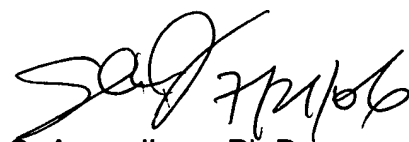
Art Unit: 1623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy P. Issac whose telephone number is 571-272-2674. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Roy P. Issac
Patent Examiner
Art Unit 1623
April 28, 2006


S. Anna Jiang, Ph.D.
Supervisory Patent Examiner
Art Unit 1623